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viewing only the file directory information contained on the data storage device, as read and communicated by the processor, through a display screen.

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13. A portable apparatus for reading only file directory information from a separately portable self contained data storage device, the portable apparatus comprising:
- at least one data storage drive for reading the file directory information from at least one respective type of data storage device;
  - a processor connected to the data storage drive programmed to read and communicate only file information; and
  - an output device connected to the processor for providing the file directory information contained on the data storage device.
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#### REMARKS

Claims 1-22 were pending in the application. Claims 1, 6, 10 and 13 have been amended. Claim 9 has been cancelled. Please enter the amendments and reconsider the application in light of the amendments and the following remarks.

#### Drawings

Corrected drawings have been submitted separately to the Official Draftsman with this response.

#### Claim Rejections Under 35 USC §102 and 35 USC §103

In the Office Action, the Examiner rejected claims 1-6, 8-16, and 18-22 35 USC §102(b) as anticipated by U.S. Patent No. 5,566,290 (Silverbrook), and claims 7 and 17 under 35 USC §103 as obvious in view of the same patent.

The Examiner's position is that "if" the media used in the Silverbrook device included "only" file directory information, then that device would necessarily read "only" such information. The Examiner's position requires an interpretation of Silverbrook that is not permitted under §103, specifically, a retrospective "what if" reading of that reference. The Examiner is not entitled to speculate as to what type of data might be stored on the media storage device of Silverbrook. A prima facie case of obviousness cannot be made

based on a modification of the teaching of a reference absent some teaching, suggestion or motivation to make such a modification. The Examiner has not presented any argument as to why the person of ordinary skill would have been led to modify the Silverbrook teaching, nor any reason that such a person of ordinary skill would have an expectation of success if any modification would have been made.

The Examiner's position also is not persuasive when one considers that the claims now recite a processor element or method (discussed below), which provides yet another difference between the claimed invention and Silverbrook. That is, the teaching of Silverbrook would need to be modified to meet the limitation that the processor of the invention be "programmed to read and communicate only file information," and there is no motivation on the record for the ordinary artisan to perform that modification.

Thus, the person of ordinary skill in the art would not have found the claimed invention obvious in view of Silverbrook.

The Examiner's comments regarding the lack of "structural" support for the claims is addressed by positively reciting the presence of a processor (in the apparatus claims) or the method of processing (in method claim 10). Support for these amendments is found at specification page 6 (as filed), lines 3-8 and also in the paragraph bridging pages 6 and 7 in the specification as-filed.

All other claims are dependent on the independent claims advocated above, and therefore all claims pending in the application should be allowed for the reasons above.

Claim 9 is positively cancelled to correct the oversight noted by the Examiner.

A marked-up version of the changes made to the claims by the current amendment is attached, entitled "**Version with markings to show changes made.**"

Please allow the application in view of these amendments and remarks. If you have any questions, please contact me at your convenience.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Peter Forrest', with a long horizontal flourish extending to the right.

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**Version with markings to show changes made**

**In the claims:**

Claims 1, 6, 10, and 13 have been amended as appears below.

1. A portable apparatus for reading only file directory information stored on a separately portable self contained data storage device, the portable apparatus not in communication with a personal computer, the apparatus comprising:
  - a handheld housing;
  - a drive component for reading the file directory information on the data storage device;
  - a loading mechanism for receiving the data storage device and retaining the data storage device such that the drive component reads the directory file information on command; [and]
  - a processor programmed to read and communicate only file information;  
and
  - a visual display operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device.
6. A portable apparatus for reading only file directory content of a separately portable data storage device, the portable apparatus not in communication with a personal computer, the apparatus comprising:
  - a handheld housing;
  - a drive component disposed within the housing to read the data storage device;
  - a processor programmed to read and communicate only file information;
  - a display disposed on the housing and connected to the drive component through the processor for viewing the file directory contents; and
  - a printer operably connected to the drive component through the processor to print the file directory contents contained on the display.
10. A method of reading only file directory information contained on a portable data storage device, the method comprising:
  - inserting the data storage device into a loading mechanism of a portable handheld file reader apparatus; [and]

with a processor, reading and communicating only file information; and

viewing only the file directory information contained on the data storage device through a display screen.

13. A portable apparatus for reading only file directory information from a separately portable self contained data storage device, the portable apparatus comprising:

at least one data storage drive for reading the file directory information from at least one respective type of data storage device; [and]

a processor connected to the data storage drive programmed to read and communicate only file information; and

an output device connected to the processor for providing the file directory information contained on the data storage device.

Claims 2-5, 7-8, 11-12, and 14-22 were not amended.

Claim 9 was cancelled.

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